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U.S. Application No. 09/709,038 Examiner LEZAK, Arrienne, Art Unit 2143  
Submission of Amendment with RCE in Response to August 12, 2005 Office Action

### **REMARKS**

In response to the final Office Action dated August 12, 2005, the Assignee respectfully requests continued examination and reconsideration based on the above claim amendments and the following remarks. The Assignee respectfully submits that the pending claims distinguish over the cited document to *Gudjonsson*.

Claims 1, 3-4, 6-12, 14-29, and 31-36 are pending in this application. The Assignee additionally presents new claims 37-47 for examination.

The United States Patent and Trademark Office (the "Office") rejected claims 1, 3-4, 6-12, 14-29, and 31-36 under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent 6,564,261 to Gudjonsson *et al.* The Assignee shows, however, that the pending claims recite features not taught or suggested by *Gudjonsson*.

### **Extension of Time**

Examiner Lezak, please note this response includes an extension of time. This response includes a petition to the Commissioner for a three month extension of time from November 12, 2005 to February 13, 2006. The 37 C.F.R. § 1.17 (a)(3) large entity fee accompanies this petition.

### **Rejection of Claims under 35 U.S.C. § 103 (a)**

The Office rejects claims 1, 3-4, 6-12, 14-29, and 31-36 under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent 6,564,261 to Gudjonsson *et al.* If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) combining prior art requires "some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill"; 2) there must be a reasonable expectation of success; and 3) all the claimed limitations must be taught or suggested by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE,

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§ 2143 (orig. 8<sup>th</sup> Edition) (hereinafter "M.P.E.P."). As the Assignee shows, the patent to Gudjonsson *et al.* fails to teach or suggest all the claims features of the pending claims.

**1. Claims 1 & 3-11 are not Obvious**

Claims 1 and 3-11 are not obvious. Independent claim 1 recites features not taught or suggested by Gudjonsson. Claim 1, for example, recites "*retrieving presence information of a second user indicating the second user's presence at a plurality of contact devices*" and "*presenting the second user's presence information to the first user, the presence information indicating the second user's presence at the plurality of contact devices.*" A "clean" version of independent claim 1 is reproduced below, and independent claims 12 and 24 recite similar features.

1. (Currently Amended) A method for presenting presence information to a first user, comprising the steps of:

retrieving presence information of a second user indicating the second user's presence at a plurality of contact devices; and

presenting the second user's presence information to the first user, the presence information indicating the second user's presence at the plurality of contact devices.

Gudjonsson does not obviate such features. Gudjonsson does not "[*present*] the second user's presence information to the first user, the presence information indicating the second user's presence at the plurality of contact devices." Gudjonsson, in contradistinction, only provides a single notion of a user's online status. Gudjonsson does not provide "*presence information indicating the second user's presence at the plurality of contact devices.*" Gudjonsson only determines whether a user is logged in without presenting a distinction of the user's online status at a plurality of contact devices. Gudjonsson, therefore, does not provide "*presence information ... at the plurality of contact devices.*"

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*Gudjonsson* provides an explanation. A user's contact list may include "the online status of other users." U. S. Patent 6,564,261 to *Gudjonsson et al.* at column 11, lines 46-51. "This status reflects whether a given user is currently logged in the system or not, thus giving information whether that user is immediately reachable." *Id.* at column 11, lines 51-54. FIG. 8 of *Gudjonsson* further illustrates this "online status" as a single icon that simply represents whether a particular user is logged in. *Gudjonsson* goes on to explain that users may specify a range of statuses, such as "online, but wish not to be disturbed or are temporarily unavailable." *Id.* at column 11, lines 56-57.

*Gudjonsson*, then, cannot obviate claim 1. *Gudjonsson* only provides a single notion and a single resulting representation of a user's online status. *Gudjonsson* does not provide "presence information indicating the second user's presence at the plurality of contact devices." Because the patent to *Gudjonsson et al.* does not teach or suggest at least this feature, one of ordinary skill in the art would not have thought that the features of claim 1 were obvious. The *prima facie* case for obviousness must fail.

Claims 3-11 depend from and include the features of independent claim 1 and are considered allowable for at least the same reasons.

**2) Independent Claims 12, 24, 37 & 43 are not Obvious**

Independent claims 12, 24, 37, and 43, and their dependent claims, are not obvious. Independent claims 12, 24, 37, and 43 all recite features not taught or suggested by *Gudjonsson*. These claims, for example, recite "presence information indicating the second user's presence at a plurality of contact devices." As the above paragraphs explained, the patent to *Gudjonsson et al.* does not teach or suggest at least this feature. One of ordinary skill in the art would not think that independent claims 12, 24, 37, and 43 are obvious, so the *prima facie* case for obviousness must fail.

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Independent claims 12, 24, 37, and 43, however, recite additional nonobvious features. Independent claims 12, 24, 37, and 43 all recite *"receiving a selection from the sender that selects a contact device to which the communication is addressed"* and *"initiating the communication from the sender to an address of the selected contact device."* A "clean" version of independent claim 12 is reproduced below, and independent claims 12, 24, 37, and 43 recite similar features.

12. (Currently Amended) A system for presenting presence information to a sender of a communication, comprising:

an input for receiving presence information of a recipient indicating the recipient's presence at a plurality of contact devices; and

a processor coupled with the input, the processor causing presentation of the recipient's presence information to the sender, the presence information indicating the recipient's presence at a plurality of contact devices, the processor receiving a selection from the sender that selects a contact device to which the communication is addressed, and the processor initiating the communication from the sender to an address of the selected contact device.

*Gudjonsson* does not obviate such features. *Gudjonsson* does not *"[receive] a selection from the sender that selects a contact device to which the communication is addressed."* *Gudjonsson* also fails to teach or suggest *"initiating the communication from the sender to an address of the selected contact device."* *Gudjonsson*, in contradistinction, utilizes a "routing service" that automatically establishes a "rendezvous" between users. This routing service completely determines where a communication is delivered — the sender need not have any knowledge of the recipient's client device. Moreover, *Gudjonsson* requires the "routing service" determine how a communication is routed and so does not teach *"receiving a selection from the sender that selects a contact device to which the communication is addressed."* *Gudjonsson* also does not initiate the communication *"from the sender to an address of the selected contact device."*

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*Gudjonsson* provides an explanation. Users send invitations to establish a communication session. U. S. Patent 6,564,261 to *Gudjonsson et al.* at column 3, lines 14-16. **"The requests are not sent directly between users."** *Id.* at column 3, lines 16-17 (emphasis added). "Instead, the routing service for the sending/inviting user sends the invitation to the routing service for the receiving user." *Id.* at column 3, lines 17-19. "The routing service for the [recipient] determines, according to a logic specified by the same [recipient], how the request is handled and what services are available to handle the request." *Id.* at column 3, lines 19-22. "[A] user may establish a communication session with another user **without knowledge of the client device ... being used by the other user; as the network arranges for communication ... between users regardless of the client device being used by the called user.**" U. S. Patent 6,564,261 to *Gudjonsson et al.* at column 3, lines 51-58 (emphasis added). **"Thus, the network enables any of the above communication services between users, and the initiating user need not know whether the other user is currently online via his/her PC or may instead be reached via pager or mobile phone."** *Id.* at column 3, lines 58-63 (emphasis added). *Gudjonsson* also discusses the advantages of this "routing service." "[R]outing services offer benefits both for the caller (invitor) and the callee (invitee)." *Id.* at column 13, lines 46-48. **"For the caller it hides the messy details on how to locate and reach a given person/user at any given time."** *Id.* at column 13, lines 49-50 (emphasis added).

FIG. 14 of *Gudjonsson* provides an additional explanation. A sender first sends an invite to the recipient. *See* U. S. Patent 6,564,261 to *Gudjonsson et al.* at FIG. 14, Block 151. The invite is sent to the sender's routing service. *See id.* at Block 153. The sender's routing service then forwards the invite to the recipient's routing service. *See id.* at Block 153. The recipient's routing service then determines how the invite is handled. *See id.* at Block 159. The recipient's routing service then forwards the invite to the recipient, depending on the recipient's logic configuration. *See* U. S. Patent 6,564,261 to *Gudjonsson et al.* at FIG. 14, Block 161.

Independent claims 12, 24, 37, and 42, then, cannot be obvious. *Gudjonsson* does not "[receive] a selection from the sender that selects a contact device to which the communication is addressed," as these claims recite. Moreover, *Gudjonsson* does not initiate the communication

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"from the sender to an address of the selected contact device." *Gudjonsson*, instead, sends invitations between the sender's and the recipient's routing service. Because *Gudjonsson* never sends invitations "directly between users," *Gudjonsson* at column 3, lines 14-16, *Gudjonsson* fails to "[select] a contact device" and initiate a communication "to an address of the selected contact device." Because the patent to *Gudjonsson et al.* does not teach or suggest these features, one of ordinary skill in the art would not have found the features of independent claims 12, 24, 37, and 42 to be obvious. The *prima facie* case for obviousness must fail.

The corresponding dependent claims are likewise not obvious. The corresponding dependent claims include the features of their respective independent claims 12, 24, 37, and 42 and are considered allowable for at least the same reasons.

#### ***Gudjonsson* "Teaches Away" from the Claims**

*Gudjonsson* "teaches away" from the pending claims. "A reference that 'teaches away' from the claimed invention is a significant factor" when determining obviousness. See M.P.E.P. at § 2145 (X)(D)(1). A reference must be considered as a whole, including portions that lead away from the claimed invention. See *id.* at § 2141.02; see also *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 U.S.P.Q. (BNA) 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). "It is improper to combine references where the references teach away from their combination." M.P.E.P. at § 2145 (X)(D)(2). If the proposed combination changes the principle of operation of the prior art being modified, then the teachings of the references are not sufficient to support a *prima facie* case. See M.P.E.P. at § 2143.01.

The Examiner's argument requires an impermissible change to *Gudjonsson*'s principle of operation. In the final office action dated August 12, 2005, Examiner Lezak states at paragraph 15 that *Gudjonsson*'s "routing service" forwards messages as set up by the receiver. Examiner Lezak therefore feels *Gudjonsson*'s routing service "removes the need for the user to have specific knowledge of available receiver devices." This reasoning, however, impermissibly changes *Gudjonsson*'s principle of operation.

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Recall that *Gudjonsson* utilizes a "routing service." This routing service **"arranges for communication ... between users regardless of the client device being used by the called user."** *Gudjonsson* at column 3, lines 51-58 (emphasis added). The **"initiating user need not know whether the other user is currently online via his/her PC or may instead be reached via pager or mobile phone."** *Gudjonsson* at column 3, lines 58-63 (emphasis added). This routing service **"hides the messy details on how to locate and reach a given person/user at any given time."** *Gudjonsson* at column 13, lines 49-50 (emphasis added).

Examiner Lezak should now realize that *Gudjonsson* "teaches away" from the pending claims. The only way for *Gudjonsson* to "[present] the second user's presence information," as the independent claims recite, is to eliminate principle operating aspects of *Gudjonsson*'s "routing service." Moreover, the only way to "[receive] a selection from the sender that selects a contact device to which the communication is addressed" (as independent claims 12, 24, 37, and 42 recite) is to entirely eliminate *Gudjonsson*'s "routing service." Likewise, the only way to "[initiate] the communication from the sender to an address associated with the selected contact device" is to again entirely eliminate *Gudjonsson*'s "routing service."

*Gudjonsson*, then, "teaches away" from the pending claims. The patent case law prohibits changing a principle of operation to support a *prima facie* case. Yet *Gudjonsson*'s principle of operation (e.g., the "routing service") must be substantially changed, or even eliminated, to support an obviousness rejection of the pending claims. Because such changes are not permissible, *Gudjonsson* cannot support a *prima facie* case. The *prima facie* case for obviousness must fail.

The pending claims, therefore, are not obvious in view of *Gudjonsson*. First, as the above paragraphs explain, the patent to *Gudjonsson et al.* fails to teach or suggest many features of the independent claims. Second, as the above paragraphs also explain, *Gudjonsson* "teaches away" from the pending claims. The *prima facie* case for obviousness must fail, so Examiner Lezak is respectfully requested to remove the § 103 (a) rejection of the pending claims.

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**Presentation of New Claims 37-47**

Examiner Lezak, please note this response presents new claims 37-47. Independent claims 37 and 43 each recite features that are similar to those of independent claims 12 and 24 and are considered allowable for at least the same reasons. Claims 38-42 and 44-47 depend from claims 37 and 43, respectively, and are considered allowable for at least the same reasons.

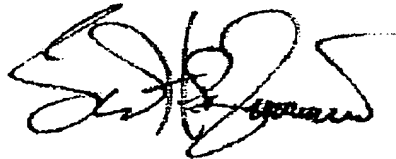
Please also note that an excess claim fee of \$950 is included. New independent claims 37 and 43 require \$400 (2 independent claims at \$200 each). Claims 37-47 also require \$550 (11 claims at \$50 each). The total excess claim fee is thus \$950 and enclosed.

For the foregoing reasons, the Assignee respectfully submits that the pending claims distinguish over the cited patent to Gudjonsson *et al.*

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If any issues remain outstanding, the Office is requested to contact the undersigned at (919) 387-6907 or [scott@wzpatents.com](mailto:scott@wzpatents.com).

Respectfully submitted,



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